



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/757,724 | 01/15/2004 | Paul H. Morrill | 05525/00003/US1 | 4582 |
| 7590 | 08/12/2009 | | EXAMINER | |
| Stanley B. Green CONNOLLY BOVE LODGE & HUTZ LLP Suite 1100 1875 Eye Street, NW Washington, DC 20006 | | | PATEL, JAGDISH | |
| | | ART UNIT | PAPER NUMBER | 3693 |
| | | MAIL DATE | DELIVERY MODE | 08/12/2009 PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/757,724 | MORRILL, PAUL H. | |
| | Examiner | Art Unit | |
| | JAGDISH N. PATEL | 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 June 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 164-221 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 164-221 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/15/09</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This communication is in response to amendment filed 6/15/09.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/15/09 has been entered.

Response to Amendment

3. New claims 164-221 have been added and remain pending. Claims 1-163 have been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 164-221 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 164 is analyzed as exemplary claim. All independent claims contain similar deficiencies and stand rejected under the same analysis and rationale.

Art Unit: 3693

Claim 164 recites limitation "preparing the wireless device to engage in a funds transfer transaction" which is vague and unclear since it fails to particularly point out what is being done to prepare the wireless device so it is engaged in a funds transfer process. A funds transfer transaction involves transfer of a specific monetary amount from one predetermined account to another. The preparing step fails to specifically point out steps being performed that affects or alters the wireless device in order that it subsequently can carry out a funds transfer transaction responsive to the subsequent selection of a function code.

The phrase "user selection of a desired funds transfer" is vague since a user desired funds transfer covers any type of funds transfer without any limits. The preparing step on the other hands only refer to a funds transfer transaction.

6. A user cannot select a function code unless he is given a list of function codes to choose from (in any form such as the choices displayed on the wireless device or on a printed list supplied with the device). Thus the claim omits essential step of providing a list of function codes which correlate to a desired funds transfer transaction, such omission amounting to a gap between the steps. See MPEP § 2172.01.

7. The limitation "without further addressing" is vague since it is recited without any reference (or relationship) to the function code or the wireless device.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 164-221 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 164-221 recite limitation that the transmission of the function code occurs "without further addressing". This negative limitation was not described in the original specification so as to comply with the written description requirement. This limitation is

a negative limitation since it excludes addressing other than function code as best understood by the Examiner in light of the 112 (second) deficiencies outlined supra.

The Applicant specifies that figures 1b through 1e, 2b and 3b through 3f do not have “further addressing” for particular communications. However, mere absence of the further addressing is not basis for the exclusion of this feature.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

Claims Objections

Status of original claims 1-98 is not indicated. Original claims must be shown with status as being cancelled (37 CFR 1.173(c)).

Newly added claims are not underlined. The newly added claims 164-221 must be underlined in their entirety (37 CFR 1.173(d)).

Claims Rejections- 35 USC 251/Defective

- the Applicants have not provided explanation mapping out the differences between the new claims and patent claims. Referring p.15 under "REMARKS", the Applicant does not address each of the newly added claims and their respective difference in scope with respect to the original patented claims 1-98.
- the reissue supplemental declaration filed 7/8/09 with the attached listing does not identify at least one 35 USC 251 error being relied upon as a basis for reissue. The error statement refers to a prior art reference in the statements of error which form basis for filing the re-issue application and does not supplement the error statement of the original declaration filed

An example of a proper error is:

"The error is that I/We claimed more than we had right to claim, specifically it was error to include limitation(s) in Claim(s) X .. while according to the invention defined in the current claims Y .. (describe the features of new reissue claims)"

In other words the error statement must reference specific claims of the patent being reissued (by numbers) with limitations which are subject of broadening and corresponding (all) new claims with respective broadened limitation(s).

(37 CFR 1.175(a)(1))

- The amendment is not accompanied by an explanation of support in the disclosure of patent for change (along with any additional comments) for each of the newly added claims. The Applicant needs to map out each limitation of each claim and show where on the patent the limitation is supported. Since all claims are newly added, it is not sufficient merely refer to the prosecution history as a guide but a new table mapping out the limitations of all newly added claims vis-à-vis the location of the disclosure where each respective limitation is supported must be provided.

(MPEP section 1453 referring to 37 CFR 1.173 (c)]

Refer to page 2 the statement that "all errors corrected ..." is defective and must be corrected as follows.

An example of acceptable language is as follows:

"All errors being corrected in the reissue application up to the time of the filing of the oath or declaration arose without any deceptive intention on the part of the applicant." (37 CFR 1.175(a) (2))

The supplemental reissue oath/declaration does not state the above statement in the foregoing acceptable language.

Accordingly all pending claims stand rejected under 35 USC 251.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 164-221 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a process to be statutory under 35 U.S.C. 101 it must (1) be tied to another statutory class (such as a particular apparatus or machine) or (2) transform underlying subject matter (such an article or materials) to a different state or thing. See recent decision by The U.S. Court of Appeals for the Federal Circuit decision in *Bilski* which established Machine-Or-Transformation Test for statutory process. Prior to this in *Gottschalk v. Benson*, 409 U.S. 63, 71, 93 S.Ct. 253, 34 L.Ed.2d 273 (1972), the Supreme Court reiterated the proposition that "a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a 'different state or thing.'" The Court referred to the well established definition of "process" stated in *Cochrane v. Deener*, 94 U.S. 780, 788, 24 L.Ed. 139 (1877). "A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing." Alternatively, "A process is a mode of treatment of certain materials to produce a given result. It is an act, a series of acts, performed upon the subject- matter to be transformed and reduced to a different state or thing."

308 F3d 1304 Schumer v. Laboratory Computer Systems Inc, 64 USPQ2d 1832, 1838 n 6 (Fed. Cir.2002).

In the instant case, none of the process steps of the method claims are tied to an apparatus such as a computer, nor do they transform a subject matter to a different state or thing. In an exemplary claim 164 none of the steps are tied to an apparatus. The only step involving an apparatus is the act of preparing the wireless device and is treated as a nominal recitation of an apparatus akin to Comiskey which stated that "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835,839-40 (Fed. Cir. 1989)). (See also *Ex Parte Langemir*, Appeal 2008-1495, BPAI Decision May 28, 2008). Also note that the wireless device itself does not perform any act since preparing is a manual act.

In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. For the same reason, claims reciting incidental physical transformations also may not pass muster under section 101. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law.

Information Disclosure Statement

9. In regards to the information disclosure statement (IDS) submitted on 6/15/09 The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. The examiner has determined that the '814 and '526 references do not teach or suggest or render

obvious the application of function code including selection, transmitting and authorizing the desired funds transfer based thereupon as stated in the present claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on Monday – Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/
Primary Examiner, Art Unit 3693